

APR 28 2006

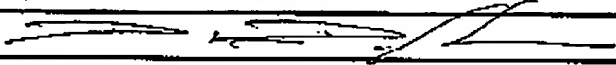
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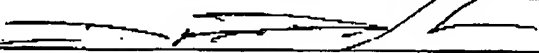
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/642,413	
	Filing Date	08/15/2003	
	First Named Inventor	George Y. Huang	
	Art Unit	2833	
	Examiner Name	TSUKERMAN, LARISA Z.	
Total Number of Pages in This Submission	12	Attorney Docket Number	Huang/Cont Raised Part

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

First Named Inventor : George Y. Huang
Applicant : George Y. Huang
Application No. : 10/642,413
Filed : 08/15/2003
For : ELECTRICAL CONNECTOR AND ADAPTER
STRUCTURE WITH RAISED PORTION
Group Art Unit : 2833
Examiner : TSUKERMAN, LARISA Z.
Attorney Docket : Huang/Cont Raised Port
Customer No. : 26860

APPEAL REPLY BRIEF, 37 CFR 41.41

April 28, 2006

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

VIA FAX (571) 273-8300

Dear Commissioner for Patents:

Appellant-Applicant George Y. Huang presents this Reply Brief to the Examiner's
February 28, 2006 Answer to Appellant's Appeal Brief.

By separate paper, Appellant has filed a request for oral hearing.

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I. INTRODUCTION

The Examiner's February 28, 2006 Answer ("Answer") raised two principal arguments. The first argument is that the "integral audio jack assembly 16" of the Tan reference anticipates independent claims 1 and 12. See Answer, at 4. The second argument is that the Owens reference renders claims 1 and 12 obvious, because "obvious alterations" to Owens were "easily performed". See Answer, at 16-17.

The first argument fails, because Tan's integral audio jack assembly (16) does not include elements and limitations recited in the rejected claims. Most significantly, the Examiner's argument, that the cylindrical rim of the audio jack provides a "design surface" that is formed as part of the "circumferential outer surface" of the audio jack, overlooked the fact that the two surfaces are separate and distinct, rather than unitary, as claimed. The first argument also fails, because the Examiner's "interpretation" of Tan's audio jack assembly as the same as the claimed surfaces is factually unreasonable. For example, the Examiner "interprets" the rim of Tan's audio jack as a "design surface" within the meaning of the rejected claim. This interpretation is simply irrational. The rim of a cylindrical audio jack does not provide a surface on which a design can be formed. On this point, the Applicant and the Examiner cannot agree, so appellate assistance is the only option.

The second argument fails, because the Examiner has failed to provide a reference or factual support for the argument that alternative forms of incorporating information or logos into a surface render claims 1 and 12 obvious. Most significantly, Examiner's factual assertion, that "obvious alterations" to Owens are "easily performed", is not only unsupported, but is directly

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contrary to Applicant's discussion of the problem the invention is designed to overcome. The rejected claims recite a structure for a "design surface" that is formed "as part of" a "background surface". The structure of the claimed invention solves the problem of electrical connectors and adapters with a design, such as a logo, applied to a surface, which requires two steps: (1) manufacturing the product with a surface, and then (2) applying a separate design to that surface. The Examiner's obviousness rejection, based on an unsupported alteration of the Owens reference, presents a structure having exactly this problem.

II. ARGUMENTS

The Examiner states that most of Appellant's arguments were based on an unclaimed, one-step manufacturing process. See Answer, at 11. This is incorrect. Appellant's Appeal Brief, as well as numerous responses to the Examiner's Office Actions, dealt at length and in depth with the Examiner's basic anticipation and obviousness references. For example, section VII.B of Appellant's Appeal Brief, at pages 10 through 15, examined in detail the Examiner's anticipation rejection based on the Tan reference. However, the Examiner's Answer fell back on an unsupported "interpretation" of Tan to respond to Appellant's arguments. As to the Examiner's conviction that Appellant is "mixed up" the application's Specification, which describes the problem of structures requiring multiple-step manufacturing, and the claims, Appellant respectfully responds that the Examiner has failed to provide legal or factual support for the argument that certain "obvious alterations" to Owens are "easily performed" and, therefore, render the claims obvious. See Answer, at 16-17. On the contrary, the alterations suggested by the Examiner involve precisely the type of structures that Applicant's claimed invention

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overcomes. Appellant respectfully submits that it is the Examiner who is confused about the legal basis for an obviousness rejection and the power of an examiner to propose unsupported factual grounds for an obviousness rejection.

A. 35 USC § 102

Appellant's Appeal Brief provides a thorough description of Tan's "three-in-one integral audio jack assembly 16" (see Tan, at Col. 2:28-29). The Examiner responds by relying on *interpretations* of Tan to support the rejection, but these interpretations are untenable.

The Examiner "interprets" Tan as showing a "portion 29" that is the claimed "raised portion", a "circumferential outer surface of a raised portion 29" that is the claimed "background surface", and a "front rim of a raised portion 29" that is the claimed "design surface". See Answer, at 11. There are two levels of difficulty with the Examiner's reasoning. At a higher, broader level, the Examiner's comparison of Tan's audio jack (29) bears no reasonable or logical relationship to the structures claimed by Applicant. For this reason, the Examiner cannot rest on Tan as it is shown and described, but must resort to a tortured, entirely subjective, and highly dubious interpretation of Tan. The Examiner admits this problem: "The Examiner is aware that the Tan structure does not look the same as the invention". See Answer, at 13. Indeed, not only does Tan look entirely different, but the specification of Tan very clearly distinguishes the audio jack assembly, as well as other components, from Appellant's claimed invention.

On the more specific level of comparison of the structures of Tan with the rejected claims, the Examiner's interpretations are equally faulty. The Examiner argues that the cylindrical rim of the audio jack (29) of Tan is a "design surface". See Answer, at 12. In its Appeal Brief,

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Appellant argued that such a rim did not provide a surface for a design and, therefore, could not constitute the claimed "design surface". See Appeal Brief, at 11. The Examiner did not address this argument, but responded that the claim terms were broad enough to read on the Tan audio jack. See Answer, at 12 ("applicant's claim language is broad"). This argument is conclusory and fails to address Appellant's specific arguments.

In fact, Tan's audio jack (16) does not anticipate the claims, as it lacks the elements and limitations in independent claims 1 and 12. The Examiner argues that the "integral audio jack assembly 16" of Tan constitutes the claimed "housing". But, Tan's audio jack (16) is a collection of parts forming an "integral" assembly, and it does not *house* anything. The Examiner responded by arguing that an "integral housing is a part of claim language". See Answer, at 13. Of course, the claims do not recite an "integral" housing. The Examiner added this limitation to make the words of the claim elements look more like the words of the Tan elements. This argument does not overcome the fact that Tan's "assembly" is not a housing, because it does not *house* anything.

The Examiner argues that the audio jack assembly (16) of Tan has the claimed "outer surface (not marked)", but the Examiner does not point out where the outer surface of Tan can be found. See Answer, at 4. In fact, because Tan's audio jack (16) is an "assembly" of many parts, it is impossible to distinguish an outer surface of one component, such as the "grounding contacts 22" (see Tan, at Col. 2:40), from another, such as the "jack units 17" (id., at Col. 2:39).

Similarly, the Examiner assumes that the "signal contacts 22" of Tan represent the claimed "one end adapted to hold an electrical connector plug". See Answer, at 4. But, the contacts (22) in Tan, are not an "electrical connector plug" as claimed, because they are shown and described as

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contacts for mating to a mother board (100). See Tan, at Col. 2:43-44.

The Examiner "interprets" Tan's audio jack "mating port 29" (see Tan, at Col. 3:43-44), as having a "circumferential outer surface" that constitutes the claimed "background surface", and a "front rim" that constitutes the claimed "design surface". See Answer, at 11. That is, the Examiner assumes that the claimed "background" and "design" surfaces are separate and read on Tan's separate "circumferential outer surface" and "front rim". But, claims 1 and 12 recite a single surface: "the exposed part of the raised portion further comprises a background surface and a design surface, ... wherein the design surface is formed as part of the background surface". Thus, the Examiner's interpretation of Tan ignored this specific limitation.

The Examiner responds to the Appellant's arguments by asserting that the claim terms are broad enough to cover Tan's audio jack assembly (16). See Answer, at 12. This argument is contrary to the facts. The rim and outer cylinder of Tan's audio jack (29) constitute entirely separate surfaces that share no space. Claims 1 and 12 include the limitation that the "design surface ... is not level with the background surface". This highlights the claims' limitation that the design surface is formed as part of the background surface and creates a design that is part of the background surface. But, Tan's separate rim and audio jack cylinder do not read on these limitations.

The Examiner argues that Tan's "frame or bracket 12" (see Tan, at Col. 2:24) is the claimed "covering formed over the outer surface of the housing". See Answer, at 12-13. But, the "frame or bracket 12" of Tan is not "formed" over the "three-in-one integral audio jack assembly 16" (see Tan, at Col. 2:28-29), but slides over it (id., at Col. 2:32). Moreover, claims 1 and 12

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recite "a covering formed over the outer surface of the housing... and around the raised portion", but Tan's "bracket 12" does not cover the entire audio jack assembly (16), and the openings (48) are not formed around the entire the entire cylindrical audio jack mating ports (29), but leave half of their surfaces uncovered. In other words, Tan's bracket does not read on these limitations

In conclusion, the Examiner's anticipation arguments are based on an unreasonable *interpretation* of Tan. The specifically cited elements of Tan do not read on the claimed elements and limitations. By failing to address Appellant's citations to Tan's specification and drawings, and relying instead on untenable interpretations, the Examiner has demonstrated that the anticipation rejections were not supported and should have been withdrawn.

B. 35 USC § 103

Over the course of prosecution, the Examiner has taken changing and inconsistent positions with respect to the Owens reference. Following the first appeal, and the amendment to incorporate the limitations suggested by the BPAI, the Examiner argued that Owens still anticipated claims 1 and 12. See January 6, 2004 Office Action ("1/6/04 OA"), at 3 ("Claims 1 and 12 are rejected under 35 U.S.C. 102(b) as anticipated by Owens"), and September 9, 2004 Office Action ("9/9/04 OA"), at 3 (same). However, the Examiner admitted that Owens did not teach the claimed design and background surfaces, but argued that these features were "ornamentation only which have no mechanical function" and, therefore, could not be relied upon to distinguish the invention from the prior art. Id., citing In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). However, the Applicant pointed out that In re Seid was an obviousness case and was contrary to the Examiner's position, which was withdrawn after the Applicant filed the

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second Appeal Brief. See July 14, 2005 Office Action ("7/14/05 OA"), at 3 and 10.¹ The Examiner also argued that Owens, standing alone, rendered certain claims obvious, because the Applicant had not disclosed that the claimed limitations would "solve any stated problem or are for any particular purpose". See 1/6/04 OA, at 4-5. This rejection was withdrawn after the Applicant noted that the Specification explained that the multi-step manufacturing process of the prior art was a problem and that the invention overcame this problem by providing a structure that could be formed in a single step.

Now, the Examiner argues that the Appellant has failed to appreciate the rejections and has confused the Specification, which explains how the invention provides a structure that can be manufactured in a single step, with the claims, which do not recite a one-step process. See Answer, at 14 ("Appellant does not claim a one-step molding process"²), 15 ("Examiner maintains that the part of the invention, which includes a manufacturing step, is not in the claims 1 and 12"; emphasis in original), and 17 ("Applicant mixed up his invention, which is disclosed into the Specification, and what Applicant really claimed").

Appellant respectfully dissents and gently complains that the Examiner's arguments concerning anticipation, obviousness, ornamentation, and manufacturing steps, have shifted and changed from office action to office action. These changing arguments indicate that the Examiner's rejection, based on the Owens reference, is influenced by a dislike for claim elements and limitations that the Examiner regards as "only ornamentation".

¹ The Examiner's Answer at issue here is to Appellant's *third* Appeal Brief.

² Actually, dependent claims 4 and 8 claim just such a process.

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As the argument currently stands, the Examiner states that the Owens reference discloses "most of the claimed invention" (see, e.g., Answer, at 6), but does "not disclose that the exposed part of the raised portion 26 forms a design surface and the design surface is formed as part of the background surface and not level with the background surface". See Answer, at 5 and 13-14. As to the undisclosed elements and limitations, the Examiner argues that Owens teaches an "informative plaque member 26" (see Owens, at Col. 3:55-56), "intended for use in applying information" (see Answer, at 5). Thus far, the Examiner's description of Owens is consistent with the Applicant's description of the prior art; namely, a separate part for a design or logo. But, the Examiner then leaps to the argument "applying information" (see Answer, at 5 and 16; emphasis added) to the "raised planar informative plaque member 26" (see Owens, at Col. 3:55-56), is the same as the claimed structure; namely, an "exposed part of the raised portion" which "further comprises a background surface and a design surface, ... wherein the design surface is formed as part of the background surface and is not level with the background surface." See Applicant's claims 1 and 12. The Examiner makes this leap based on the unsupported factual speculation that the "informative plaque 26" of Owens could have been created by "obvious alternatives", such as etching and appliques. See Answer, at 5-6 and 16. The Examiner bases this claim on the additional unsupported factual assertion that such "obvious alternatives" are "easily performed". Id. The Examiner never provides a reference, suggestion, motivation or factual basis for this claim which, therefore, amounts to nothing more than speculation.

The statute defines obviousness as "differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at

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the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." See 35 USC § 103(a). The Examiner argued that Appellant's claimed structure could be achieved in Owens based on the Examiner's subjective and unsupported factual conclusion that they were "obvious alternatives" that were "easily performed". These factual assertions are legally faulty, because they are not based on anything other than the Examiner's opinion.

To support an obviousness rejection, the Examiner was required to identify a primary and secondary references. Durling v. Spectrum Furniture Co., 101 F.3d 100, 103 (Fed. Cir.1996), citing In re Harvey, 12 F.3d 1061, 1063 (Fed. Cir. 1993). The secondary references may only be used when a suggestion or motivation to combine the primary and secondary references to create the claimed design is identified. Hupp v. Siroflex of America, Inc., 122 F.3d 1456, 1462 (Fed. Cir.1997); see also MPEP §706.02(j) (setting forth the three criteria required to establish a *prima facie* case of obviousness requires, including identification of suggestion or motivation to modify or combine reference teachings). The Examiner failed to meet this burden.

The Examiner's claim also directly contradicts the factual assertions of Applicant's Specification. The Applicant stated that *applying* a design or logo through an additional manufacturing step was a problem the invention was intended to overcome. Insofar as the Examiner's argument is based on the unsupported factual claim that "applying information" designs is "easily performed", the Applicant's claimed invention distinguishes such a process by claiming that the "design surface is formed as part of the background surface".

In summary, all of the Examiner's arguments based on the Owens reference fail to meet

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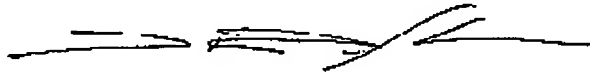
the requirements for an obviousness rejection, because the Examiner's factual claim, that "applying information" is "easily performed", contradict the Applicant's description of the problem the claimed invention overcomes.

III. CONCLUSION

For the foregoing reasons, it is submitted that the Examiner's rejections are without legal support, and reversal of the Examiner's decision is respectfully requested.

Dated: April 28, 2006

Respectfully submitted,



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Attorney for Appellant-Applicant,
George Y. Huang